

REMARKS

The applicants have reviewed the Final Action mailed by the Office on 9 March 2004 and the art cited therein. The applicants submit this paper in response to this Final Action, and request entry and favorable consideration of this response.

5 Independent claims 21 and 68 stand rejected under § 102(b) as being anticipated by Malec. The applicants respond to these rejections as follows, discussing several features that are not believed shown by Malec. Based on any one of these reasons, the applicants submit that Malec does not support a § 102(b) rejection of these independent claims because it does not disclose each feature recited in these claims. The applicants thus request reconsideration and
10 withdrawal of the rejections of these two independent claims, and all claims depending therefrom, to the extent they are based on Malec.

The applicants also include comments on the applicability of the Fano reference to dependent claims 205 and 207.

15 1. *Regarding independent Claim 21, Malec Does Not Determine Its Offered Item Based On The User's Geographic Position, The User's Identity, And A Further Data Element.*

The applicants quote the following passage from claim 21 for convenience of discussion:

20 “utilizing at least in part the geographic position of the user, the at least further data element, and the identity of the user to determine the at least one offer for the item in real time with the primary transaction;”

As recited in this passage, the claimed invention requires utilization of three criteria in selecting the offered item: first, the geographic position of the user; second, the further data element related to the user; and finally, the identity of the user. Turning to Malec, it appears that
25 the only means Malec provides for identifying the user is the smart card reader referenced in column 24, lines 40-56. Even assuming, only for the purposes of this discussion, that the demographic data stored on the smart cards is an analogue to the “further data element” recited in the applicants’ claims, and further assuming that the coupons, targeted advertisements, and/or awarded loyalty points referenced by Malec are “items” as recited in applicants’ claims, the role

(if any) played by the geographic position of the shopper in determining which of these “items” are offered to the shopper is unclear, as discussed in further detail below. Instead, it appears that, at most, these “items” are selected based on the identity of the shopper swiping the smart card and whatever demographic information is stored on the smart card, irrespective of the shopper’s position within the store.

Turning to Malec’s teaching relating to the applicants’ “geographic position” feature, it appears that the only means Malec provides for determining the department in which the shopper is browsing are the trigger transmitter 512, in connection with the transceiver electronics mounted on the respective shopping carts. However, this aspect of the Malec system does not appear to be integrated with the smart card reader system discussed above. Malec’s only explicit teachings regarding the data obtained via the smart card reader appears to be contained in column 22, lines 40-50. Conspicuously absent is any teaching here, or elsewhere in Malec, to integrate this identity or demographic data as input into the selection of messages to be displayed on the cart’s SCD electronics 514 in response to the signals from the trigger transmitters 512. Accordingly, it is not clear how, if at all, the data obtained using the trigger transmitters 512 plays into the selection of the “items” discussed in the previous paragraph. Malec does not appear to teach integrating the data collected from the trigger transmitters 512 with the data collected using the smart card reader when determining what messages to present on the cart display electronics 514. However, the applicants submit that Malec must do so to anticipate the above-quoted passage from independent claim 21. Accordingly, on at least this basis, the applicants request reconsideration and withdrawal of the § 102(b) rejections of claim 21, and all claims depending therefrom, to the extent these rejections are based on Malec.

2. *Regarding independent Claim 68, Malec Does Not Determine Its Offered Item Based On The User’s Geographic Position And A Further Data Element.*

The applicants quote the following passage from claim 68 for convenience of discussion:

“utilizing at least in part the geographic position of the user and the at least further data element to determine the at least one offer for the item in real time with the primary transaction,”

While this passage from claim 68 does not require utilizing the user's identity in determining the item to offer to the user, the applicants nevertheless submit that Malec fails to disclose the features recited in this passage, for reasons similar to those discussed above in connection with claim 21. The applicants submit that Malec fails to teach integrating demographic data captured from its smart card readers (assuming only for this discussion that this demographic data is an analogue for the applicants' recited "further data element") with data relating to the trigger transmitters 514 and related transceiver electronics (assuming only for this discussion that this data is an analogue for the applicants' recited "geographic position") in selecting (1) which items to present on the cart display electronics 512, or in selecting (2) which coupons, targeted advertisements, or loyalty points to award the shopper. It appears that Malec chooses the former based only on the data relating to the trigger transmitters 514, and chooses the latter based only on the data captured from the card reader. However, the applicants submit that Malec must integrate these two streams of data to select one of these items to meet the features recited in the above passage. On at least this basis, the applicants submit that Malec does not meet all features recited in claim 68, and request reconsideration and withdrawal of the § 102(b) rejection of claim 68, and all claims depending therefrom, to the extent such rejections are based on Malec.

3. *Malec Fails To Disclose Obtaining Data Representing A Geographic Location Of The User As Part Of The Primary Transaction.*

The applicants reproduce the following language from independent claim 21 for convenience of discussion:

"obtaining primary transaction data related to the primary transaction, the primary transaction data including at least data representing an identity of the user and data representing a geographic position of the user"

A corresponding paragraph in the other independent claim, claim 68, recites a similar feature pertaining to data representing the geographic position of the user, so these comments are equally applicable to either claim 21 or claim 68.

As understood by the applicants, the Final Action applied the "primary transactions" recited in claims 21 or 68 to the Malec shopper's swiping of a smart card as described in column

24, lines 40-56, and to the shopper's pushing the cart near enough to a given trigger transmitter 512 to receive a signal therefrom, as described throughout Malec's specification. However, even under this interpretation of the claim language, the applicants submit that Malec derives any data representing a shopper's location not from the primary transaction, as recited in claims 21 and 68, but instead from sources other than the primary transaction. As discussed by Malec in column 7, lines 52-61, Malec provides a local database present in the ISC 502 that contains shelf location information relating to given trigger transmitters 512. Malec discusses accessing this database to perform inventory checks to ensure that goods advertised on the SCD electronics 514 are in stock at the store. Malec also discusses a "product look-up table" in column 8, line 6 and an "interactive store directory" in column 8, line 19. The role played by the internal database in supporting these latter two functions is not clear from Malec. However, to the extent that Malec's teachings may correspond to the "geographic location" data claimed by the applicants, these aspects of location information taught by Malec originate from sources other than the "primary transactions" conducted with the shopper, as recited in claim 21 and 68.

Further, to the extent that Malec obtains data representing a geographic position of the shopper/user, this geographic position originates from data that is well "downstream" of the primary transaction, rather than originating from the primary transaction itself. Finally, Malec does not appear to teach using data from either the internal database referenced in column 7, the product look-up table referenced in column 8, or any data store supporting the "interactive store directory" referenced in column 8 as input into the process by which the messages for display on the SCD electronics 514 is chosen. For at least these reasons, the applicants submit that Malec does not support a § 102(b) rejection of independent claims 21 and 68, and all claims depending therefrom, because it fails to disclose at least the above feature recited in these independent claims. Accordingly, the applicants request reconsideration and withdrawal of these § 102(b) rejections.

4. *The Fano Reference Is Not Prior Art As To Dependent Claims 205 And 207.*

Paragraph 7 of the Final Action rejected claims 205 and 207 under § 103(a) as being unpatentable over Malec in view of Fano (US Patent No. 6,317,718). The applicants first submit

that claims 205 and 207 are fully supported by the parent Katz patent (No. 6,055,513) at least at column 9, lines 33-40; column 17, lines 50-55; and column 21, lines 45-50. These passages discuss various aspects of determining a customer's geographic indication by obtaining and analyzing the telephone number from which the customer dialed a call to execute a primary transaction. Clearly, information related to the telephone number dialed by the customer would be available to a call center in real time with the primary transaction sought by the customer. Thus, claims 205 and 207 have an effective filing date of 11 March 1998. Turning to the Fano '718 patent, its effective date as a reference is its filing date of 26 February 1999. Thus, the Fano '718 patent is not effective prior art against claims 205 and 207, and the applicants thus request reconsideration and withdrawal of the rejections based on this reference.

The applicants request favorable action at the earliest convenience of the Office. If discussion of this application or this response would advance prosecution of the instant application, the Office is requested to contact Rocco Adornato at the telephone number indicated below.

Respectfully submitted,

WEST CORPORATION

Dated: 10 May 04

By: 

Rocco L. Adornato, Reg. No. 40,480



29129

PATENT & TRADEMARK OFFICE

11808 Miracle Hills Drive
Omaha, Nebraska 68154
(402) 965-7170